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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,493	01/14/2002	John D. Polk	06556.0039	9208

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EXAMINER	
CHEUNG, MARY DA ZHI WANG	
ART UNIT	**PAPER NUMBER**
3694	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/043,493	POLK ET AL.	
	Examiner	Art Unit	
	Mary Cheung	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-266* is/are pending in the application.

4a) Of the above claim(s) *1-200 and 235-266* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *201-234* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-266* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/8/02;9/20/02;10/11/02;12/12/02;1/16/03;9/10/04.

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on January 14, 2002. Claims 1-266 are pending. Claims 201-234 (Invention IV) has been elected without traverse as per telephone interview with attorney Erika Arner on March 6, 2007. Thus, claims 201-234 are examed and claims 1-200 and 235-266 are withdrawn from consideration.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-102, drawn to payment and disbursement, classified in class 705, subclass 40.

II. Claims 103-148, drawn to registering and storing employer information, classified in class 707, subclass 100.

III. Claims 149-200, drawn to payment through financial clearinghouse, classified in class 705, subclass 53.

IV. Claims 201-234, drawn to process payment for a plurality of intermediaries, classified in class 705, subclass 78.

V. Claims 235-266, drawn to filtering information using a template, classified in class 707, subclass 3.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has

separate utility such as disbursement based on the disbursement information; subcombination II has separate utility such as registering an employer; subcombination III has separate utility such as financial clearinghouse; subcombination IV has separate utility such as batch files; and subcombination V has separate utility such as filtering information using a template. See MPEP § 806.05(d).

4. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Erika Arner on March 6, 2007 a provisional election was made without traverse to prosecute the invention of IV, claims 201-234. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-200 and 235-266 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 201, 205-207, 209, 212, 214-217, 221-223, 225, 228 and 230-234 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn et al., US 6,401,079 B1.

As to claim 201, Kahn teaches a method for processing payments over a network for a plurality of intermediaries, comprising (abstract and column 11 line 59 – column 12 lines 10 and column 12 lines 45-60 and Fig. 3; *"intermediaries" corresponds to the miscellaneous payees in Kahn's teaching, such as child support agencies*):

- Receiving employee information from a plurality of employers via network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier (column 5 lines 36 – column 6 line 7 and column 11 line 59 – column 12 line 10 and column 12 lines 45-60);
- Processing at least one employee debit corresponding to the employee information for each employee (column 11 line 59 – column 12 line 10 and column 19 lines 12-32 and Fig. 3);
- processing a credit corresponding to each employee debit (column 19 lines 12-36 and Fig. 3);
- batching the credits into a plurality of batch files based upon the intermediary identifier (column 19 lines 12-52 and column 39 lines 10-24 and Fig. 3); and
- sending each batch file to an intermediary based on the intermediary identifier (column 19 lines 12-52 and column 39 lines 10-24 and Fig. 3).

As to claim 205, Kahn teaches delivering each batch file to each intermediary using a communication method matching the intermediary identifier (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 206, Kahn teaches the communication method is electronic funds transfer (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 207, Kahn teaches the communication method is electronic data interchange (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 209, Kahn teaches the network is the Internet (Fig. 1).

As to claim 212, Kahn teaches the network is a wired network (Fig. 1).

As to claim 214, Kahn teaches the employee information relates to a child support payment (column 12 lines 45-60).

As to claim 215, Kahn teaches the debits are processed using debit-based electronic funds transfer (column 19 lines 12-32).

As to claim 216, Kahn teaches the credits are processed using addendum-based electronic data interchange (column 6 line 19-23 and column 19 lines 43-52 and column 51 lines 14-30 and Fig. 3).

Claims 217, 221-223, 225, 228 and 230-234 are parallel with the limitations in claims 201, 205-207, 209, 212 and 214-216; thus, they are rejected on the same basis.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 208, 210-211, 213, 224, 226-227 and 229 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Official Notice.

As to claims 208, 210-211, 213, 224, 226-227 and 229, Kahn does not specifically teach the communication method is paper, the network is an intranet, the network is a wireless network, and the network is a virtual private network. Examiner

takes Official Notice for these limitations. It would have been obvious to one of ordinary skill in the art to allow Kahn's teachings to implement these features because by implement these well known in the art features would better meet the users'/employers' needs for attracting more people use Kahn's payroll system.

13. Claims 202-204 and 218-220 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Embrey, US 6,311,170 B1.

As to claims 202-204 and 218-220, Kahn teaches processing the employee debit corresponding to the employee information for each employee , and receiving a credit corresponding to the employee debits as discussed in claim 201 above. Kahn does not specifically teach verifying the employee information using verification information received from an intermediary, processing the employee debit corresponding to the employee information for each employee, when the employee information is verified, and receiving a credit corresponding to the employee debits, when the employee information is verified. However, this matter is taught by Embrey as the trusted financial institution uses the verification information received from the payee to verify the payor information, and process the disbursement between the payor and the payee if the information is positively verified (column 3 lines 49-55 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kahn's teaching to include the feature of process the disbursement between the payor and payee upon the positively verification by using the verification information received from the payee as taught by Embrey for preventing fraudulent transactions.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 201-234 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 5,946,669. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose disbursement between an employee and a recipient.

16. Claims 201-234 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 6,119,107. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose disbursement between an employee and a recipient.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

Mary Cheung
March 20, 2007

MARY D. CHEUNG
PRIMARY EXAMINER